

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANNETTA BEATTY

Appeal No. 97-1133
Application 08/424,247¹

ON BRIEF

¹ Application filed April 17, 1995. According to appellant, the application is a continuation of Application 08/198,904, filed February 18, 1994, abandoned; which is a reissue of U.S. Patent 5,135,279, issued August 4, 1992, which derived from Application 07/728,647, filed July 11, 1991.

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Before COHEN, FRANKFORT and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 5, 8, 11, 14 and 16. Claims 3, 4, 6, 7, 9, 10, 12 and 13 stand allowed. Claim 15, the only other claim pending herein, has been objected to by the examiner and indicated to be allowable if rewritten in independent form. Claim 2 has been canceled.

Appellant's invention relates to a shade assembly for the windshield or windows of a motor vehicle. Claim 1 is representative of the subject matter on appeal and a copy of that claim, as it appears in the Appendix to appellant's brief, is attached to this decision.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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Kivikink et al. (Kivikink) 1923	1,468,115	Sept. 18,
Selph 1975	3,868,293	Feb. 25,
Bryngelson 1991	5,024,479	June 18,

(filed Nov. 16, 1989)

Additional prior art references relied upon by this
panel of the Board in a new rejection of all of the pending

claims in this application under 37 CFR § 1.196(b) are:

Stulbach 1965	3,183,033	May 11,
Klose 1990	4,979,775	Dec. 25,

Claims 1, 5, 8, 11, 14 and 16 stand rejected under
35 U.S.C. § 103 as being unpatentable over Kivikink in view of
Bryngelson and Selph.

Rather than reiterate the examiner's full statement
of the above-noted rejection and the conflicting viewpoints

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advanced by the examiner and appellant regarding the rejection, we make reference to the final rejection (Paper No. 17, mailed November 27, 1995) and to the examiner's answer (Paper No. 24, mailed October 17, 1996) for the examiner's complete reasoning in support of the rejection, and to appellant's brief (Paper No. 23, filed September 4, 1996) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of

our review, we have made the determination that the examiner's rejection of the appealed claims under 35 U.S.C. § 103 is not well founded and will therefore not be sustained. However, we have also decided to enter a new ground of rejection against

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all of the pending claims in this application under our authority provided by 37 CFR § 1.196(b). Our reasoning in support of these determinations follows.

Turning first to the examiner's rejection of the appealed claims under 35 U.S.C. § 103, we share appellant's view that there is no teaching or suggestion in the applied prior art references which would have led a person of ordinary skill in the art to selectively modify the antiglare screen or shade of Kivikink in the manner urged by the examiner. It is our view, after a careful review of these references, that in searching for an incentive for modifying the shade of Kivikink, the examiner has impermissibly drawn from appellant's own teachings and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

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Since we have determined that the examiner's conclusion of obviousness is based on a hindsight reconstruction using appellant's own disclosure as a blueprint to arrive at the claimed subject matter from disparate teachings in the prior art, it follows that we will not sustain the examiner's rejection of appealed claims 1, 5, 8, 11, 14 and 16 under 35 U.S.C. § 103.

Under the authority provided by 37 CFR § 1.196(b), as amended December 1, 1997, we make the following new rejection of all of the claims pending in this application.

Claims 1 and 3 through 16 are rejected under 35 U.S.C. § 103 as being unpatentable over Klose in view of Stulbach or Kivikink and Selph.

As noted on page 1 of appellant's specification in the "BACKGROUND OF THE INVENTION," Klose (U.S. Patent No. 4,979,775) discloses a windshield shade assembly like that defined in appellant's pending claims, with the exception that

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the shade members (8) of Klose are not indicated to be made of a "transparent plastic polarized material" which would allow the shade members to be used to protect the driver's eyes from the glare of

the sun, while not otherwise limiting his vision or restricting his field of view. Klose does not specifically indicate what material the shade (8) is made from, but, notes at column 1, lines 36-39, that the window shade therein is intended to substantially improve screening of a windshield and thus improve the protection against sunlight and against light from oncoming vehicles.

Stulbach discloses an antiglare shield or shade for a motor vehicle windshield (58) wherein the retractable shade members (e.g., 52, 54) are made of transparent plastic sheets which are tinted or pigmented to be of different colors, such as, blue and yellow, respectively (col. 2, lines 60-62). Each shade is said to be pigmented so that glaring sunlight, street lights and other elevated lights are most effectively excluded

by the darker upper portions thereof, while the lower portions which receive little glare are lighter in tint or color so as to provide a better view of the roadway to the driver (col. 4, lines 17-23).

Kivikink, like Stulbach, discloses an antiglare shade or screen for a motor vehicle window wherein a retractable shade member (4) may be made of "any material suitable for tempering or

diminishing the glare of light without obscuring the driver's view of the roadway" (page 1, col. 2, lines 92-94). In particular, Kivikink notes that the shade member (4) is preferably made of transparent colored celluloid.

Selph discloses a reusable glare eliminator for use in the windows of a motor vehicle. After discussing the prior art attempts to use a tinted visor or patch to reduce or eliminate the glare from the sun or other light sources (col. 1, lines 17-27), Selph suggests that a patch of polarized

cellulose acetate, which may be tinted, can be employed to provide the desired glare elimination, without the need of the fairly heavy tinting required in the prior art devices.

After a collective evaluation of the teachings of the applied references, it is our opinion that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to have made the shade members (8) of Klose from a transparent tinted plastic material so as to block a substantial portion of sunlight or other glare producing lights that may impinge on the window, and to provide such an advantage without otherwise obscuring the driver's view of the roadway, as

clearly suggested in Stulbach or Kivikink. We further consider that, based on the teachings of Selph, a person of ordinary skill in the art would have been led to select a transparent, tinted plastic polarized material as the particular material from which to make the shades (8) of Klose so as to gain the advantages noted in Selph (i.e., so as to

block the desired degree of light, without unnecessarily impairing the driver's view of the roadway and without the need for the fairly heavy tinting used in the prior art).

With particular regard to previously allowed independent claims 3, 7, 9 and 13, and the claims which depend therefrom, we note again that the shade assembly of Klose is fully responsive to the dual shade arrangement set forth in these claims, except for the particular material from which the shade members are made. As already articulated above, it is our opinion that it would have been obvious to one of ordinary skill in the art, from the combined teachings of Klose, Stulbach, Kivikink and Selph, to modify the shade arrangement of Klose to utilize a transparent, tinted plastic polarized material as the particular material from which the shades (8) are made, so as to gain the noted advantages clearly set forth in the secondary references.

To summarize, the decision of the examiner to reject claims 1, 5, 8, 11, 14 and 16 under 35 U.S.C. § 103 is

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reversed; however, a new ground of rejection against claims 1 and 3 through 16 has been entered by this panel of the Board under 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the

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application will be remanded to the
examiner. . . .

(2) Request that the application be
reheard under § 1.197(b) by the Board of
Patent Appeals and Interferences upon the
same record. . . .

No time period for taking any subsequent action in
con-nection with this appeal may be extended under 37 CFR §
1.136(a).

REVERSED, 37 CFR § 1.196(b)

	IRWIN CHARLES COHEN)	
	Administrative Patent Judge)	
)	
)	
)	BOARD OF
PATENT)	
	CHARLES E. FRANKFORT)	APPEALS AND
	Administrative Patent Judge)	
INTERFERENCES)	
)	
)	
	JEFFREY V. NASE)	
	Administrative Patent Judge)	

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APPENDIX

1. A shade assembly for a vehicle windshield comprising:

at least two brackets attachable at a top of the windshield at respective spaced apart locations of the windshield and

at least one flexible shade member, said shade member being made of a transparent plastic polarized material that blocks a substantial portion of sunlight; and

a shade winding mechanism secured between said at least two brackets, said shade winding mechanisms including a non-rotatable axle having opposite ends securable in said brackets and a cylindrical shaft rotatably mounted about said axle, said shade member being fastened by one longitudinal edge to the shaft so as to be vertically extendable such that a vertical dimension of said shade varies upon rotation of said shaft, and that when said shade is fully extended a substantial portion of a vertical dimension of said windshield is covered to block sunlight when in an unwound position and when in a wound position said shade is wound upon the shaft.